

REMARKS

Rejection and Amendments

The sole remaining ground of rejection is the rejection of claims 46-48 under 35 USC §112, first paragraph, on grounds of alleged lack of written description. Specifically, the examiner asserts that the feature "wherein Q is not either -CHOH- or -CHOH- in which the OH group is esterified," recited in claim 46 does not have basis in the disclosure and thus is new matter. Applicants strongly disagree.

As stated in the rejection, MPEP §2173.05 clearly states that negative limitations or exclusionary proviso clauses are permissible, so long as they have basis in the original disclosure. The case law also supports this position. See, e.g., *In re Johnson*, 194 USPQ 187 (CCPA 1977). In that case, a patent applicant excluded two classes of linker groups from the claimed genus (i.e., carbonyl and sulfone). The court held this was permissible because the specification disclosed the two linker groups that were being excluded. Specifically, the court held that the subgenus, in which the two linker groups were excluded from the genus, did **not** constitute new matter.

As with the excluded linker groups in *Johnson*, the embodiments of Q excluded from claim 46 are disclosed in the applicants' specification. Applicants' specification clearly discloses that Q can be a straight-chain or branched carbon unit with up to 10 carbon atoms, which at any positions can have α - or β -hydroxyl groups, and these hydroxy groups can be etherified or esterified. See, e.g., page 5, lines 15-19. In addition, the specification undeniably discloses that Q can have hydroxyl groups at any positions, and lists -CH(OH)- as an example, and then further states that the hydroxyl groups can in turn be esterified or etherified. See, e.g., page 7, lines 3-10.

Clearly, applicants' disclosure more than reasonably conveys possession of the concept of Q being -CHOH- or -CHOH- in which the OH group is esterified. Thus, this concept has basis in the original disclosure and therefore a genus which excludes such embodiments by means of an exclusionary proviso clause does not constitute new matter. Compare *Johnson*.

In any event, for purposes of furthering prosecution, claims 46-48, the only rejected claims, are cancelled. Thus, the application is in condition for allowance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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Filed: February 27, 2006